IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: 2433

ANURADHA NARASIMHASWAMY ET AL.

Examiner: Carl G. Colin

Serial No.: 09/558,192

Filed: April 26, 2000

For: ON-LINE INVENTION DISCLOSURE APPROVAL SYSTEM

Attorney Docket No.: FMC 2086 PUS

REPLY TO EXAMINER'S ANSWER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed October 30, 2009, please consider the following remarks:

Remarks

> In the Examiner's Answer, the
>
> Examiner asserts that the claim language *requesting a next available docket information number for the permanently locked disclosure* is not equivalent to the original specification which merely states making a request or requesting a docket ID number. The original specification as filed did not explicitly describe the request as a request of the next available docket information number for the permanently locked disclosure. Also, the disclosure system that makes the request has no knowledge of what the next available docket information number is in the docketing system as to requesting specifically the next available docket information number for the permanently locked disclosure.
>
> Examiner's Answer, October 30, 2009, page 30 (emphasis in original).

Appellants continue to draw the Examiner's attention to page 11, lines 4 through 12, page 14, line 25 through page 15, line 4, and page 17, lines 18 through 30 of the Application. For example, page 11, lines 4 through 10 state that

> When approval has been obtained from each co-inventor, the accept disclosure submission block 56 locks the document so no further changes can be made and obtains a docket ID number from a docketing system 58. The disclosure system makes the request and the docket system provides the next available docket number.
>
> Application, page 11, lines 4 though 10 (emphasis added).

Appellants have pointed out that "[a]ll disclosures of Takano (or Lemble as modified by Takano), whether approved/locked or not, will have a reference number," Appeal Brief, page 9, and that "Lemble as modified by Takano does not yield the claimed invention," Appeal Brief, page 9. The Examiner appears to agree as the Examiner has effectively (and improperly) issued a new grounds of rejection: the Examiner now cites Mahoney for teaching "requesting and obtaining a next available docket number after locking the document." Examiner's Answer, October 30, 2009, page 33 (emphasis in original). Claim 1, however, is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,315,504 (Lemble),

U.S. Pat. No. 5,031,214 (Dziewit), Applicants' Admitted Prior Art (AAPA), and U.S. Pat. No. 6,434,580 (Takano)—not Mahoney. Moreover, the Examiner provides no explanation as to why one of ordinary skill would have had reason to combine Mahoney with Takano. "The Federal Circuit[, however,] has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" MPEP 2142. Here, the Examiner merely asserts that "for at least the reasons above, the rejection of claim 1 should be sustained." Examiner's Answer, October 30, 2009, page 33.

Respectfully submitted,
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Date: December 29, 2009

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